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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,430	07/21/2003	Michael J. Yagley	PU2165	1429
23454	7590	03/25/2004	EXAMINER	
CALLAWAY GOLF COMPANY 2180 RUTHERFORD ROAD CARLSBAD, CA 92008-7328			GORDON, RAEANN	
			ART UNIT	PAPER NUMBER

3711

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/604,430

Applicant(s)

YAGLEY ET AL.

Examiner

Raeann Gorden

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2003.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7-21-03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nesbitt et al (6,663,509). Regarding claim 1, Nesbitt discloses a golf ball comprising a solid core, an inner cover layer, and an outer cover layer. The inner cover layer is equivalent to applicant's intermediate layer. The solid core can be made from butadiene and has a diameter from 1.34 to 1.638 inches (col. 29, lines 30-33; col. 33, lines 26-29). The outer cover layer has a thickness from 0.01 to 0.1 inch (col. 39, lines 35-36). The outer cover (ball hardness) is 55 or less Shore D (col. 17, lines 20-22). The coefficient of restitution (COR) for the ball is at least 0.790 (col. 18, lines 5-8). Nesbitt also discloses the USGA standard indicates that a regular golf ball cannot have an initial velocity exceeding 255 feet per second (col. 8, lines 37-40). Regarding claim 2, the inner cover layer has a Shore D hardness of 60 or more (col. 9, lines 30-33). Regarding claim 3, for the purposes of claim 3 the outer core layer of the dual core is equivalent to applicant's intermediate layer. A thread layer surrounds the outer core layer. Regarding claim 4, the golf ball has a diameter of 1.68 inches. Regarding claim 5, the outer cover may be made from ionomers or polyurethane (col. 17). Regarding

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claims 6 and 7, the outer cover (ball hardness) is 55 or less Shore D (col. 17, lines 20-22). Regarding claim 8, the solid core has a diameter from 1.34 to 1.638 inches (col. 33, lines 26-29). Regarding claim 9, the inner cover layer may be made from a blend of sodium and zinc ionomers (cols. 9-10). Regarding claims 10-12, Nesbitt discloses a golf ball comprising a solid core, an inner cover layer, and an outer cover layer. The inner cover layer is equivalent to applicant's intermediate layer. The solid core can be made from butadiene and has a PGA compression less than 90 (col. 29, lines 30-33; col. 32). The inner cover layer has a Shore D hardness of 60 or more (col. 9, lines 30-33). The inner cover layer may be made from thermoplastic materials. The outer cover layer has a thickness from 0.01 to 0.1 inch and may be made from thermoset polyurethane (col. 17; col. 39, lines 35-36). The coefficient of restitution (COR) for the ball is at least 0.790 (col. 18, lines 5-8). Nesbitt also discloses the USGA standard indicates that a regular golf ball cannot have an initial velocity exceeding 255 feet per second (col. 8, lines 37-40). The outer cover (ball hardness) is 55 or less Shore D (col. 17, lines 20-22). Regarding claims 13 and 19, Nesbitt discloses a golf ball comprising a solid core, an inner cover layer, and an outer cover layer. The inner cover layer is equivalent to applicant's intermediate layer. The solid core has a PGA compression less than 90 and a mass from 25 to 40 grams (col. 32). The inner cover layer is made from an ionomer and has a Shore D hardness of 60 or more (col. 9, lines 30-33). The inner cover layer has a thickness from 0.01 to 0.1 inch (col. 9, line 25). The outer cover layer has a thickness from 0.01 to 0.1 inch and may be made from polyurethane (col. 17; col. 39, lines 35-36). The coefficient of restitution (COR) for the ball is at least 0.790

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(col. 18, lines 5-8). Nesbitt also discloses the USGA standard indicates that a regular golf ball cannot have an initial velocity exceeding 255 feet per second (col. 8, lines 37-40). The outer cover (ball hardness) is 55 or less Shore D (col. 17, lines 20-22).

Regarding claims 14-16, the outer cover layer has a thickness from 0.01 to 0.1 inch and may be made from polyurethane (col. 17; col. 39, lines 35-36). One of ordinary skill in the art would have varied the ranges of Nesbitt to achieve the desired golf properties.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,595,872. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application and the '872 patent claim identical subject matter. Rearranging the limitations does not render a patentable distinction.

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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raeann Gorden whose telephone number is 703-308-8354. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Raeann Gorden  
Examiner  
Art Unit 3711

Rg

March 20, 2004